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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,938	03/03/2004	Cor Van Rijn	03/018 KP	4127
38263 7590 01/14/2008 PROPAT, L.L.C. 425-C SOUTH SHARON AMITY ROAD CHARLOTTE, NC 28211-2841				
			EXAMINER MIGGINS, MICHAEL C	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,938

Applicant(s)

VAN RIJN ET AL.

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/18/07 has been entered.

REJECTIONS WITHDRAWN

2. There are no rejections withdrawn.

REJECTIONS REPEATED

3. All the rejections either set forth or maintained in the final rejection of 3/5/07, page 2, paragraphs 2 is repeated for the reasons of record.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huguen et al. (US 5747192) in view of Tyson (GB 1186531, provided herein).

For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48USPQ2d at 1355 ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). See also *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964) (applies to instant claim 24).

Huguen discloses whose upper of lower side comprises a metallizing layer composed of aluminum, or copper, brass, or bronze (since 5,292,566 discloses this and is incorporated by reference, column 1, lines 56-67), wherein said film is metallized (column 1, lines 42-54), wherein said film has a negative heat shrinkage of from about 5 to 8% (column 5, lines 29-37), wherein said film consists essentially of at least one rigid polyvinyl chloride film (since only a single layer is disclosed, column 2, lines 43-67,

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column 3, lines 31-38). It is to be noted that reference is good for all it discloses not just the preferred embodiments.

ANSWERS TO APPLICANT'S ARGUMENTS

6. Applicant's arguments of 6/18/07 have been carefully considered but are deemed unpersuasive.

Hughen discloses a single layer (column 2, lines 43-67) and multi-layer (column 1, lines 42-67) and a reference is good for all it discloses not just the preferred embodiments.

Applicant has argued that the PVC film of Hughen is not rigid. However, the term rigid is not defined in the claims or the specification. Limitations from the specification or prior art are not read into the claims. Furthermore, Hughen discloses that the film is self supporting which means that the film is at least somewhat rigid (column 2, lines 45-50).

Applicant has argued that Hughen fails disclose a PVC film having a width of up to about 2010 mm. However, the range, as written, is technically from about 0 (emphasis added) to 2010 mm and a battery pack has a width which is between 0 and 2010 mm and since the film covers the battery pack the film has a width which is between 0 and 2010 mm.

Applicant argues that Hughen fails to disclose the film which is calendered from 180 to 60 degrees C in the machine direction. However, Tyson discloses the film which

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is calendered from 180 to 60 degrees C in the machine direction (page 1, lines 42-48 and page 2, lines 5-15).

Applicant argues that Huguen discloses a polypropylene backing film and not PVC. However, Huguen discloses PVC backing film (column 3, lines 31-38).

Applicant has argued that Huguen does not disclose the negative shrinkage of about 0 to 10% as recited in claim 2. However, Huguen specifically discloses a negative shrink of from 0 to 10% (column 5, lines 29-36). Furthermore, Huguen clearly discloses that the elongation described in column 5, lines 32-37 describes negative shrinkage since Huguen specifically states that negative shrinkage means elongation (column 5, lines 36-37)

Applicant has argued that Huguen does not disclose the recited temperatures at which the shrinkage occurs. However, Tyson discloses the recited temperatures at which the shrinkage occurs (page 2, lines 5-15 and page 2, lines 67-94). Furthermore, the temperatures are method limitations which are not germane to the patentability of a product in a product claim (MPEP 2113).

Applicant has argued that Tyson does not disclose that the film is rigid. However, Huguen discloses a rigid film as discussed above.

Applicant has alleged that the heat shrinkage of Tyson takes place at 70 degrees C. However, Tyson clearly discloses that the heat shrinkage temperature is 120 degrees C (page 2, lines 67-94) and discloses a temperature as high as 140 degrees C (page 2, lines 5-15). While Tyson discloses that the laminate temperature is 70 degrees, the treatment temperature is 120 degrees C and applicant is claiming the

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treatment temperature not the laminate temperature. Furthermore, the temperature of the treatment is a method limitation and method limitations are not germane to the patentability of a product in a product claim (MPEP 2113).

Applicant has argued that Huguen and Tyson are drawn to different fields of endeavor. However, the examiner respectfully disagrees since both references are drawn to PVC shrink films.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is the lower cost and ease of operation of using a hot air oven.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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Applicant has argued that Huguen does not disclose whose upper or lower side comprises a metallizing layer composed of aluminum, or copper, brass, or bronze, wherein said film is metallized, wherein said film has a negative heat shrinkage of from about 5 to 8%, wherein said film consists essentially of at least one rigid polyvinyl chloride film. It is to be noted that reference is good for all it discloses not just the preferred embodiments. However, Huguen discloses these limitations are disclosed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is 571-272-1494. The examiner can normally be reached on 1:00-10:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCM
August 20, 2007

Michael C. Miggins
Primary Examiner
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